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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,989	10/13/2005	Peter Forsell	2333-137	4862
23117 7590 12/23/2009 NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203				
EXAMINER				
STOKLOS, JOSEPH A				
ART UNIT		PAPER NUMBER		
3762				
MAIL DATE		DELIVERY MODE		
12/23/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/527,989

Applicant(s)

FORSELL, PETER

Examiner

JOSEPH STOKLOSA

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/200)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-19 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant's newly amended independent claims 1, 10, 11, and 21 contain the new limitation that the shielding, "surrounding the coil, except ***at least*** the front end (emphasis added)." Applicant has failed to provide support within the written specification as originally filed for such a limitation in combination with the other claimed limitations. Further, Examiner has considered the newly added limitation to be a negative limitation/ exclusionary proviso. The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. MPEP 2173.05(i). While applicant has provided support within the written specification as originally filed, at least in drawings, for the shield member failing to surround the front end, applicant has introduced an new open ended range for the shield, since this new range encompasses embodiments where there is no shield,

and lacks support within the written specification as originally filed, in combination with the other claim limitations.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 32 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claim 32, recites first and second transmitters, and depends upon claim 10. Claim 10 fails to provide antecedent basis for first and second transmitters. It appears applicant has intended for claim 32 to depend upon claim 11. Examiner has interpreted claim 32 to depend upon claim 11, however appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6, 8, 10, 12-14, 16, 18, and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolbert (US 4,985,922) in view of Zarinetchi (US (US 6,324,430).
8. Kolbert discloses a system for transmission of power and data signals through a medium with an alternating magnetic field comprising a coil for generating outside the medium with windings (e.g. windings 28; Col. 3, line 9-10), with a front/bottom end

directed to the medium and corresponding receiver unit, and a rear/top end that faces away from the medium and corresponding receiver as seen in Fig. 2. It is also seen in Fig. 2, that the coil structure and windings extend longitudinally.

9. Kolbert further discloses an integral shield with a ferromagnetic core that extends longitudinally through the coil as seen in Fig. 2 (e.g. housing 22 and core 26). As seen in Fig. 2, housing member 22, surrounds all sides of the coil except the bottom/front of the coil where only a magnet is placed about the periphery of the housing to hold the unit in place against a metallic medium.

10. Kolbert fails to explicitly teach the use of the transfer system for use with an implanted medical device and the medium being a patient's skin. Zarinetchi teaches that it is known to use an inductively coupled coil system for use in transferring power/data to a medical implant transcutaneously as set forth in the ABSTRACT for providing the predictable results of providing greater patient comfort through non-invasively providing power to an implant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kolbert with use of the transfer system for use with an implanted medical device and the medium being a patient's skin since such modifications would provide the predictable results of providing greater patient comfort through non-invasively providing power to an implant.

11. With regard to claim 6, Examiner considers the top of the housing to be a gable wall that is integrally joined with the core and circular cylindrical walls.

12. With regard to claim 8, Kolbert discloses the housing is ferromagnetic (e.g. Col. 3, lines 4-5).

13. Claims 5, 7, 11, 15, 17, 22-31, 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolbert in view of Zarinetchi as applied above.

14. With regard to claim 11, Kolbert in view of Zarinetchi fails to disclose the use of two transmitters. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kolbert in view of Zarinetchi with the use of two transmitters since such a modification would provide the predictable results of ensuring efficient recharging of implanted medical device that is located internally and migrates by diametrically opposition of the transmitters such that the implant will be located in between the two and at least one transmitter will be able to more efficiently couple.

15. With respect to claims 5, 7, 15, 17, 22-23 Kolbert in view of Zarinetchi disclose the invention as claimed but fails to teach the core longitudinally extending beyond the length of the shield and cut out slots on the sides of the shield. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kolbert in view of Zarinetchi with providing cut out slots on the side of the shield which would yield a system where the core and coil windings extend longitudinally beyond the shield for providing the predictable results of providing ventilation for the skin surface and dissipation of any excess heat energy stored within the shield member.

16. Claims 9, 19, 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolbert in view of Zarinetchi as applied above and in further view of Winkler (US 5,527,348).

17. Kolbert in view of Zarinetchi disclose the invention as claimed, but fails to teach a plastic casing surrounding the shielding that places the coil and core at a distance in the order of centimeters away from the user's hand. Winkler teaches that it is known to use a plastic casing to house the external coil assembly and would place the users hand at a distance on the order of centimeters away from the coil as set forth in Col. 4, line 35-48 and Figs. 1-2 for providing the predictable results of creating a more aesthetically pleasing unit by covering the internal components as well as providing a buffer between the operator's hand and the magnetic field created by the coil. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system as taught by Kolbert in view of Zarinetchi with the use of a plastic housing that places the coil away from the users hand at a distance of the order of centimeters since such a modification would provide the predictable results of creating a more aesthetically pleasing unit by covering the internal components as well as providing a buffer between the operator's hand and the magnetic field created by the coil. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the plastic housing to place a users hand in the order of centimeters since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art [*In re Aller*, 105 USPQ 233] and/or since it has been held that a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778

F.2d 775, 227 USPQ (Please see MPEP 2144.05). Further, Examiner considers the User's hand to be located in the order of centimeters. Any distance can be looked at as in the order of centimeters, i.e. 0.01 centimeters to N centimeters. Applicant's claim fails to specify "at least" how many centimeters the user's hand be placed.

Response to Arguments

18. Applicant's arguments filed 9/9/2009 have been fully considered but they are not persuasive.

19. Applicant argues that the combination of Kolbert in view of Zarinetchi would not have been obvious due to non-analogous art. In response to applicant's argument that Kolbert and Zarinetchi are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, both Zarinetchi and Kolbert are within the field of Applicant's endeavor, that is the field of transmission of an alternating magnetic field through a medium and both are reasonably pertinent to transmission of alternating magnetic fields through mediums.

20. Applicant argues that Zarinetchi and Kolbert relate to transmission through a medium to a receiver at the surface of the medium, and not to a receiver deeply implanted within a body. Examiner reminds that this is not a claimed limitation. Applicant's claimed invention requires the receiver to simply be implanted.

21. Applicant argues that neither Kolbert nor Zarinetchi disclose a shield having a portion surrounding the circumference of the coil along at least a portion of the longitudinal extension of the coil, and a shield comprising a core integrated with a housing. Examiner respectfully disagrees. Kolbert explicitly discloses an integral shield with a ferromagnetic core that extends longitudinally through the coil as seen in Fig. 2.
22. Applicant argues that it would not have been obvious to use at least two transmitters. Examiner respectfully disagrees. Examiner cites as evidence Kung (US 6,400,991) for teaching the use of at least two external transmitting coils for supplying power to an implanted secondary coil(s).

Conclusion

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSEPH STOKLOSA whose telephone number is (571)272-1213. The examiner can normally be reached on Monday-Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571-272-4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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12/9/2009